C. REMARKS

1.   Status of the Claims

Claims 1-20 are currently present in the Application and stand rejected. Claims 1, 8, and 14 are independent claims. No claims have been amended, cancelled, or added in this Response.

2.   History of Prosecution

The first Non-Final Office Action (mailed 12/19/2003) rejected claims 1-20 under 35 U.S.C. § 102(b) as allegedly being anticipated by an Oracle Human Resources manual by Cafolla. The undersigned attorney interviewed the Examiner on March 3, 2004 and explained that the cited reference did not teach Applicants' invention. These differences were further discussed in Applicants' response filed March 11, 2004. In Applicants' Response, Applicants further discussed why the deficiencies of Cafolla would not be overcome under § 103 if the Examiner decided to combine the reference with another reference. At this time, Applicants also noted that the Examiner did not indicate whether Applicants' drawings had been accepted.

The second Non-Final Office Action (mailed 5/05/2004) again rejected claims 1-20 and again failed to indicate whether Applicants' drawings had been accepted. In the second action, the claims were rejected under § 103 as being allegedly obvious in light of Cafolla in view of U.S. Pat. No. 6,236,996 to Bapat. Once again, in Applicants' Response filed August 5, 2004, Applicants explained why the art did not teach or suggest Applicants' claimed invention. For a second time, Applicants

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also requested that the Examiner indicate whether Applicants' drawings had been accepted.

The Final Office Action (mailed 1/21/2005) maintained the rejections of the Second Non-Final Office Action. As pointed out in detail in Applicants' prior Response filed 8/5/2004, the art cited by the Examiner simply did not teach or suggest any of Applicants' claims. Applicants responded by Appealing the Final Office Action. Applicants' Appeal Brief, filed June 21, 2005, recited essentially the same arguments as were provided in the Response to the Second Non-Final Office Action. In spite of the fact that the Examiner maintained these same rejections in the Final Office Action, the Examiner evidently realized that Cafolla in view of Bapat did not teach or suggest Applicants' invention and Reopened Prosecution.

The third Non-Final Office Action (mailed 8/10/2005) reopened prosecution in light of Applicants' Appeal Brief. The present Office Action cites completely new references (§ 102 citing Lei and § 103 citing Lei in view of Miller) and does not rely on either of the references cited in the previous actions. Indefensibly, this Third Non-Final Office Action once again does not indicate whether Applicants' drawings have been accepted, even though Applicants have respectfully requested consideration of Applicants' drawings in each of their past responses.

3.   **Drawings**

As noted above, this marks the ***third time*** that Applicants have respectfully requested consideration of their formal drawings. Once again, Applicants respectfully request that the Examiner indicate whether the drawings are accepted.

4.   <u>Claim Rejections - 35 U.S.C. § 102 - Alleged Anticipation</u>

Claims 1-3, 5-6, 8-9, 10, 12-16, and 18-20 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated and therefore unpatentable over U.S. Patent No. 6,487,552 to Lei et al. (hereinafter "Lei"). Applicants respectfully traverse the rejections.

A claim in anticipated under § 102 only if each and every element of the claim is found, either expressly or inherently, in a single prior art reference. MPEP § 2131 states, in part:

> **TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM**
>
> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

As described in further detail below, Lei falls far short of teaching each and every element of Applicants' independent claims. Comparing the claim limitations found in Applicants'

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independent claims with the teachings of Lei make this amply clear.

Each of Applicants' independent claims include the limitations of selectively displaying employee profiles comprising the steps of:

- selecting one or more employees to exclude from a first view, the first view including employee profile information corresponding to a plurality of employees;

- excluding the employee profile information corresponding to the selected employees from the first view, the exclusion resulting in a second view; and

- granting view access to the second view to one or more of the selected employees.

As previously discussed with the Examiner during the previous Examiner Interview, as well as discussed in Applicants various Responses and Appeal Brief, Applicants' claims require (1) selection of one or more employees, (2) excluding data regarding the selected employees from a view that includes employee data, and (3) granting access to the view to one or more of the selected employees (those employees whose data does not appear in the view). This invention is directed towards a method/system/program product used by managers and other supervisors when evaluating employees. For example, if a project managed by a project manager has 100 employees divided into 5 different departments with one person in each of the departments being the department manager that is reviewing the other employees (5 managers), then Applicants' invention could be used to exclude the 5 managers from a view of the 100 employees (leaving 95 employees in the view) and then granting the 5 managers view access to the view of the 100 employees. Using Applicants' invention, the managers would be able to

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review the employees throughout the project without the managers
seeing data pertaining to the other department managers. The
above description and example is obviously meant to help the
Examiner understand Applicants' claimed invention and is not
meant to further limit the claims beyond the limitations found
in the claim.

As explained below, Lei simply does not teach or suggest
each of these limitations. The present Office Action cites Lei,
col. 1, lines 62-65, col. 2, lines 34-45, col. 3, lines 51-60,
and col. 15, lines 25-31 as allegedly teaching each and every
limitation set forth in Applicants' independent claims. As
explained in detail below, the teachings of Lei fall
considerably short of teaching Applicants' claimed invention as
set forth in the independent claims. The cited sections of Lei
read as follows:

- **Lei, col. 1, lines 62-65:**

    To restrict a user to a particular subset of rows
    within a table, the user may be granted rights to
    access a view that extracts from the table only those
    rows that belong to that particular subset. For
    example, assume that a table "t" has two columns
    "text" and "lang".

The above-referenced section simply states that a user can
be granted rights to access a view of a table that belong to a
"particular subset." Importantly, Lei never teaches or suggests
that the "particular subset" is a group of employees.
Furthermore, Lei never teaches or suggests that the user's own
data is excluded from the view before the user is granted rights
to the view, as taught and claimed by Applicants in each of the
independent claims.

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- <u>Lei, col. 2, lines 34-45:</u>

   V3:

   SELECT * from t

   WHERE t.lang=`English`

   AND t.security_level<=3

   AND t.dept=`Insurance`

   View V3 uses "hard-coded" literals, such as `English`,
   3, and `Insurance`. The use of hard-coded literals in
   view definitions can have serious performance
   implications. Specifically, the use of literals
   renders similar queries (that would otherwise be able
   to share query plans and resources) into distinct
   queries that can share no resources.

The above-referenced section provides an example of creating a view. Again, this section does not exclude any particular records (i.e., records corresponding to a particular user) and does not grant any particular user access to the view. Instead, the example provided by Lei is a simple view of a database table where all records are selected where the language is "English," the security level is equal to or below "3," and the department is "Insurance." Nowhere does the SQL taught by Lei select records similar to records claimed by Applicants. Applicants are selecting a group of employees and <u>excluding</u> one or more employees. Lei teaches or suggests no such exclusions. Furthermore, Lei does not teach or suggest granting anyone a view to the view, let alone individuals that were excluded from the initial selection, as taught and claimed in Applicants' independent claims.

Lei, col. 3, lines 51-60

   In addition to the problem of view proliferation,
   another problem associated with using views to
   implement an access policy is that not all policy

rules can be easily evaluated by the database server. For example, if the access control policy is "a user accessing the EMP table as a Payroll clerk through the Payroll application is allowed to see all EMP information, including SALARY, but only for employees in her division," then views will probably not be able to implement the policy, since the database server will not be able to determine what application a user is using.

The above-referenced section discusses using access control policies to control what records an employee is authorized to view. An example provided by Lei is that a payroll clerk may be authorized to view employee data, including salaries, for employees in her division. Lei does not teach or suggest excluding the payroll clerk from the view prior to granting the payroll clerk access to the view. Instead, in Lei's example, the payroll clerk would not be excluded from the view, as the payroll clerk is obviously one of the employees "in her division."

Lei, col. 15, lines 25-31:

> For example, a particular query may retrieve data through a first view, where the first view retrieves data through a second view, where the second view retrieves data from table t. Under these conditions, the database server will determine that table t is being accessed at the time the particular query is being parsed.

The above-cited section simply teaches the cascading of views where a first view retrieves data from a second view and is completely inapposite to Applicants' claimed invention. This section does not teach what records are included in any of the views and does not teach or suggest which employees are granted access to any of the views.

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As shown above, Lei does not teach each and every limitation set forth in each of Applicants' independent claims. In particular, Lei does not teach or suggest selecting one or more individuals and ***excluding*** the selected individuals' records from a view and then ***granting*** one or more of the selected individuals access to the created view, as claimed in each of Applicants' independent claims. Therefore, each of Applicants' independent claims is allowable over Lei.

Each of the remaining claims depend, directly or indirectly, on one of the independent claims. Consequently, each of the dependent claims is also allowable over the art of record for at least the same reasons that the independent claims are allowable.

5.   Claim Rejections – 35 U.S.C. § 103 – Alleged Obviousness

Claims 4, 7, 11, 17, and 20 stand rejected under 35 U.S.C. § 103 as being allegedly obvious and therefore unpatentable over U.S. Patent No. 6,487,552 to Lei et al. (hereinafter "Lei") in view of U.S. Patent No. 6,587,668 to Miller et al. (hereinafter "Miller"). Applicants respectfully traverse the rejections.

As an initial matter, each of these claims depends on an independent claim and each of the independent claims are allowable for the reasons set forth in the preceding section. Accordingly, each of these claims is also allowable for at least the same reasons that the independent claims are allowable.

Claims 4, 11, and 17 each add the following limitation to the independent claim: "wherein the first view corresponds to a manager and wherein each of the excluded employee profiles corresponds to an employee that reports to the manager." The

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Office Action contends that this limitation is taught by Miller at col. 5, lines 30-35. This section of Miller reads as follows:

> Users may also be assigned a manager. The user's manager is designated by the user_mgr_id field, which references another user_id. User information is stored in a users table, which has a primary key consisting of user_id. A user record has foreign keys to the divs, levels, cost_centers, and locations tables.

Evident from Miller and the section cited above, neither Miller nor Lei teach or suggest selecting employees to exclude from view and then granting access to the view to one or more of the excluded employees. The cited section simply discusses the well known fact that users in an organization might have a manager. In Miller's corporate educational system, a field is provided to store the manager information.

Claims 7 and 20 each add the following limitations to their respective independent claims:

- displaying a list of reporting employees to a manager; and

- wherein the selecting includes receiving one or more exclusion selections from the manager in response to the displayed list.

The Office Action alleges that these additional limitations are taught by Miller at col. 5, lines 30-35, the text of which was provided above in the discussion of claims 4, 11, and 17. Interestingly, nowhere does Miller teach or suggest "displaying a list of reporting employees." Instead, Miller simply states that a user might have a manager and that the manager's ID can be included in a field of the user's record. In addition, Miller does not teach or suggest anything to do with receiving selections from "the manager" as claimed in claims 7 and 20.

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Therefore, in sharp contrast to the allegations set forth in the Office Action, neither Miller nor Lei taken alone or in combination with one another teach or suggest the limitations set forth in Applicants' claims 7 and 20.

In short, Lei in view of Miller completely fail to teach or suggest the limitations set forth in Applicants' claims 4, 7, 11, 17, and 20. Therefore, each of these claims is allowable for the reasons set forth above in addition to the fact that each of these claims is allowable because they depend on allowable independent claims.

Furthermore, Applicants' respectfully submit that there is simply no motivation, found in the prior art, to combine the database teachings of Lei with the educational system taught by Miller. Instead, Applicants respectfully submit that the present Office Action improperly used Applicants' claims as "guideposts" in selecting the references and simply concluded that it would be "obvious" to combine the references. In doing so, Applicants assert that the present Office Action used impermissible hindsight in combining Lei and Miller in order to support a rejection of Applicant's claims.

MPEP § 706 states:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

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combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 – § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 – § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be

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compelled to testify in legal proceedings regarding their
mental processes (see MPEP § 1701.01), it is important that
the written record clearly explain the rationale for
decisions made during prosecution of the application.

Applicants assert that the Office Action fails to satisfy
the burden set forth in § 706.02(j) in support of an obviousness
rejection, particularly because there is no motivation to
combine the references.   Therefore, the Office Action used
impermissible hindsight in rejecting Applicants' claims and the
resulting combination is not a workable solution.   As the
references have been improperly combined, Applicants
respectfully request that the rejection under § 103 be
withdrawn.

Conclusion

As set forth above, Applicants respectfully submit that the
rejection of Applicants' claims 1-20 has been traversed.   An
allowance of claims 1-20 is therefore respectfully
requested.Applicants respectfully request that the Examiner
contact the Applicants' attorney listed below if the Examiner
believes that such a discussion would be helpful in resolving
any remaining questions or issues related to this Application.

Respectfully submitted,

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